

15 JUN 2006



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In re Application of
Ike et al.
Application No. 10/518,986
PCT No.: PCT/JP02/11181
Int. Filing Date: 28 October 2002
Priority Date: 10 July 2002
Atty. Docket No.: F-8518
For: Paper Feed Roller And
Fabrication Method Thereof

COMMUNICATION

This is in response to the "Submission of Declaration" filed on 26 January 2006, which is being treated under 37 CFR 1.42.

BACKGROUND

This international application was filed on 28 October 2002, claimed an earliest priority date of 10 July 2002, and designated the U.S. The International Bureau communicated a copy of the published international application to the USPTO on 22 January 2004. The 30 month time period for paying the basic national fee in the United States expired at midnight on 10 January 2005. Applicants filed, *inter alia*, the basic national fee on 21 December 2004.

On 26 September 2005, a Notification of Missing Requirements (Form PCT/DO/EO/905) was mailed to applicants, requiring the submission of an oath or declaration compliant with 37 CFR 1.497(a) and (b) and the surcharge under 37 CFR 1.492(h).

DISCUSSION

Counsel states that "the second inventor, Kazuhiro OOSAKI, has passed away and has not signed the Declaration. Inspection of the declaration filed on 26 January 2006 reveals that it nominates and provides citizenship, residence and postal address information for Kazuhiro Oosaki, but it has not been signed by and does not provide citizenship, residence and postal address information for an individual or individuals indicated to be a legal representative (or all of the heirs) of Kazuhiro Oosaki, as required for relief under 37 CFR 1.42.

Meanwhile, counsel also refers to "a Declaration (with Exhibits (A) to (K)) executed by Toshiji SUGA," who appears from the evidence of record to be an employee of an assignee, SUNCALL CORPORATION, and whose statements include statements related to the issue of whether the wife of the deceased inventor refused to execute an oath or declaration or could not be found or reached after diligent effort, per 37 CFR 1.47(b).

Based on the totality of the evidence presented, it is unclear what type of relief counsel is requesting (i.e., whether relief is sought under 37 CFR 1.42, under 37 CFR 1.47, or under both 37 CFR 1.42 and 1.47). In the event that relief is sought under 37 CFR 1.42, counsel is required

to satisfy all of the requirements of that regulation, including presenting an oath or declaration stating all of the required facts and signed on behalf of the deceased inventor by his legal representative or all of his heirs. In the event that relief is sought under 37 CFR 1.47(b), counsel's attention is respectfully directed to MPEP 409.03(c), which states that

37 CFR 1.47 should not be considered an alternative to 37 CFR 1.42 or 35 U.S.C. 117 since the language "cannot be found or reached after diligent effort" has no reasonable application to a deceased inventor. In re Application Papers Filed September 10, 1954, 108 USPQ 340 (Comm'r Pat. 1955). See 37 CFR 1.42 and MPEP § 409.01. However, 37 CFR 1.47 does apply where a known legal representative of a deceased inventor cannot be found or reached after diligent effort, or refuses to make application. In such cases, the last known address of the legal representative must be given (see MPEP § 409.03(e)).

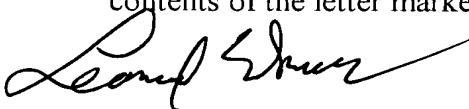
In the event that counsel is seeking relief under BOTH 37 CFR 1.42 AND 37 CFR 1.47(b), the oath or declaration should be prepared for signature on behalf of the deceased inventor by his legal representative (or all of his heirs) per 37 CFR 1.42, and counsel should then provide the appropriate showing under 37 CFR 1.47(b) why the absence of the signature(s) of the legal representative (or all heirs) should be excused.

CONCLUSION

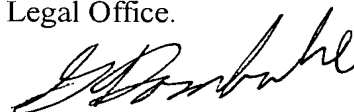
The declaration is **NOT ACCEPTED**, without prejudice.

A proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are available. Failure to file a timely response, including a renewed submission under 37 CFR 1.42 and/or 37 CFR 1.47(b) will result in **ABANDONMENT**.

Any further correspondence with respect to this matter should be addressed to the Assistant Commissioner for Patents, P.O. Box 1450, Mail Stop PCT, Alexandria, VA 22313-1450, with the contents of the letter marked to the attention of the PCT Legal Office.



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